

II. Remarks

The Office Action of October 6, 2003, Paper No. 3, was carefully reviewed and to highlight the distinctions of the above referenced invention. Applicants have amended the title to emphasize the novelty of the invention. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

The Office Action set forth restriction requirements under 35 U.S.C. §121 (and presumably also under 37 CFR §§1.141 and 1.142): between Claims 9 through 25 as Group I, Claim 26 as Group II, Claims 27 through 32 as Group III, and Claim 33 as Group IV. Applicants hereby traverse the restriction requirements under the authority of 37 CFR §1.143. Notwithstanding the traversal, Applicants, as required in the Office Action, hereby confirm the provisional election of the claims of Group I for further prosecution in this application. Applicants' attorney, however, respectfully submits that the requirement for restriction is improper, as a matter of law and fact, for the following reasons.

First, as a matter of law, Applicants respectfully submit that the claims of Groups I, II, III, and IV are not "independent" of one another, as required by both statute and the applicable Rules of Practice. A purported showing of distinctness of two or more inventions does not, in and of itself, justify a requirement for restriction under 35 U.S.C. §121, or under 37 CFR §§1.141 and 1.142. Under 35 U.S.C. §121, and 37 CFR §§1.141 and 1.142, it is respectfully submitted that a requirement for restriction requires a showing that the two or more inventions that are claimed in a

single application be both "...independent and distinct...", (emphasis added) a showing which, it is further respectfully submitted, has not yet been made in this application.

It is respectfully submitted that it will not be possible to make a showing that the invention of the Group I, II, and IV claims are, in fact, "independent" of one another, as those terms are defined in MPEP §§802.01 and 806.04. Specifically, MPEP §806.04 addresses the term "independent" for two combinations of an invention. MPEP §806.04(A) defines "independent" as "[t]wo different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects...", and cites as an example "[a] process of painting a house and a process of boring a well..." In contrast, the method of Groups I, III, and IV do not meet this definition of independent, nor do they even come close to comparison with the example given in the MPEP. Here, the claimed inventions are so similar that they are not only capable of use together, they are intended for use together, have similar modes of operation and similar functions and effects. In fact, the claimed inventions of Groups I, II, and IV all stem from the same basic process as summarized in the flow charts of Figures 3A and 3B in the application. The limited differences between the claimed inventions of Groups I, II, and IV represent "...various optional steps and alternatives..." as stated on page 18, line 18 of the specification.

It is further respectfully submitted that it will not be possible to make a showing that the invention of the apparatus claims of Group II, on the one hand, and the invention of the method claims of Groups I, III, and IV, on the other hand, are, in fact, "independent" of one another, as those terms are defined in MPEP §§802.01 and

806.04. MPEP §802.01 addresses the question of whether or not process and apparatus claims are "independent" under 35 U.S.C. §121 and 37 CFR §1.141, and defines the term "independent" as meaning that "there is no disclosed relationship between the two or more subjects disclosed", which, in the second example dealing with process and apparatus claims, requires a showing that the apparatus is "incapable of being used in practicing the process" (emphasis added). Applying the requirement for a showing that the method and apparatus claims of this application are, indeed, "independent" of one another, as that term has been defined in MPEP §802.01, it is respectfully submitted that the apparatus defined by Claim 26 is not only capable of, but clearly is intended for, being used in practicing the process of the Group I, III, and IV claims.

Likewise, MPEP §806.04 further defines the term "independent" as meaning that for inventions that are related as to process and apparatus, the inventions are independent if "the apparatus cannot be used to practice the process or any part thereof..." (emphasis added). Clearly, the method of the Group I, III, and IV claims do not meet this definition of independent with respect to the apparatus of Claim 26 because the only disclosed utility for the process and apparatus is "for permanently attaching an overlay...to a wheel...". Therefore, the apparatus necessarily can be used to practice the process, and indeed is intended for use with the process. In fact, the apparatus of Claim 26 recites hardware that is specifically used to accomplish the methods of Claims 9 through 25, Group I and Claims 27-32, Group III.

Accordingly, it is respectfully submitted that the requirement for restriction in this application is, at the very least, premature, because there has not yet

been a showing that the inventions defined by the noted groups of claims are "independent" of one another, as required under 35 U.S.C. §121, 37 CFR §§1.141 and 1.142, and MPEP §§802.01 and 806.04. It is further respectfully submitted that the requirement for restriction in this application is improper because it has not and will not be possible to make a showing that the inventions of the noted claim groupings are "independent" of one another under 35 U.S.C. §121, 37 CFR §§1.141 and 1.142, and MPEP §§802.01 and 806.04.

Second, the examples that the Examiner set forth in an effort to distinguish the process from the apparatus do not meet the requirement of "provid[ing] reasonable examples that recite material differences" as required by MPEP §806.05(f). The Examiner set forth as an example of a materially different process, "...Invention I has separate utility such as a process for permanently attaching an overlay to a wheel without the particular steps of Invention III." It is not understood how the claims of Invention I are materially different from those of Group III and IV, when they are both directed to permanently attaching an overlay to a wheel, and both stem from the same basic process. Further, and with respect to the apparatus and method claims, an apparatus for permanently attaching an overlay to a wheel is explicitly used in conjunction with a corresponding method for permanently attaching the overlay to the wheel. Therefore, it is not understood how an apparatus specifically directed to "permanently attaching an overlay to a wheel" could be used with another process not directed to "permanently attaching an overlay to a wheel," and likewise it is respectfully submitted that the Examiner has not set forth a reasonable example or explanation. Therefore, it is respectfully submitted that the Examiner's examples fall

short of explicitly “providing reasonable examples that recite material differences,” as required by MPEP §806.05(f).

Third, and looking directly to the language of one of the applicable rules of, namely 37 CFR §1.141(b), “...the process of using may be joined with the claims directed to the product (or apparatus)...even though a showing of distinctness between the product and process of using the product can be made.” Therefore, the explicit language of the Patent Rules allow for joining claims directed to a process of using a product or apparatus with the product itself, in a single application.

Fourth, and as a matter of fact, both the method and apparatus claims in the application clearly require “...permanently attaching an overlay...to a wheel...”. Thus, both the method and apparatus, as claimed, are to be used within the same exact environment or with the same product. The fact that the method and apparatus claims are classified in different classes should be no basis for the requirement of a restriction by itself.

Lastly, the claims of Groups I, III and IV are classified in the same class and subclass, and the Examiner has not established a prima facie case for restriction by showing that the Groups have a separate status in the art, or that a different field of search is necessary, as explicitly required by MPEP §808.02. A proper showing of separate status in the art requires an explanation indicative of a recognition of separate inventive effort by inventors, specifically citing patents which are evidence of such separate status (MPEP §808.02(b)). Here, it is respectfully submitted that the Examiner has not submitted such an explanation or evidence, and

thus, has not made a proper showing of separate status, or that a different field of search was necessary.

Accordingly, reconsideration and withdrawal of the requirements for restriction in this application are respectfully requested. Since the provisional election of the Group I claims has been confirmed herein, the Applicants will address the Examiner's requirement for an election of species with respect to the Group II claims upon notification that the requirement for restriction has been formally withdrawn.

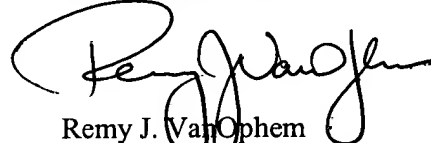
Applicants respectfully submit that the claims as presented particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Accordingly, formal allowance thereof is requested.

In view of the foregoing remarks, the undersigned attorney respectfully submits that the independent claims as well as the dependent claims as now pending are in proper form, define patentable subject matter, and are clearly allowable. Accordingly, Applicants' attorney respectfully requests that a formal Notice of Allowance be issued therefor.

If the Examiner has any questions with respect to any matter now of record, Applicant's attorney may be reached at (586) 739-7445.

Respectfully submitted,

VANOPHEM & VANOPHEM, P.C.

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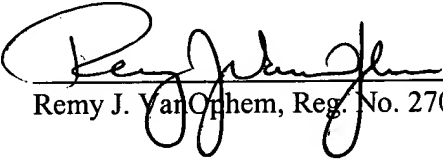
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